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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/208,696	12/10/1998	YASUYUKI SEKINE	RM.HPK	8464

7590

03/11/2004

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DETROIT, MI 48226

EXAMINER
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COLLINS, DOLORES R

ART UNIT	PAPER NUMBER
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3712

31

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/208,696

Applicant(s)

SEKINE, YASUYUKI

Examiner

Dolores R. Collins

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-4,6,7 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4,6,7 and 11-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Examiner acknowledges response by applicant's representative received 1/20/04.

#### ***Claim Rejections - 35 U.S.C. § 103***

**The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 11, 2-4, 6, 7 & 12-15 are under 35 U.S.C. 103(a) as being unpatentable over Sankyo K.K.

Sankyo discloses, as his invention, a Game Machine.

#### Regarding claim 11

Sankyo teaches a gaming machine with a multiplicity of game states with corresponding game symbols (see abstract & figures 2-4), predetermined win and loss states (hit) (abstract & figure 22), a display portion (reels) (shown in figures 2-4 & 22)

Further, in his slot machine he teaches a display that has 2 or more identical symbols appearing serially, as shown in the main figure of his invention.

Sankyo discloses the claimed (display) invention with the exception of the teaching of 2 or more identical special symbols in all three columns. It would be obvious to one of ordinary skill in the art at the time the invention was made to duplicate the teaching of 2 or more identical special symbols shown in the right and left columns (drums) as shown in the aforementioned figure, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Additionally, the serially appearing symbols of Sankyo's disclosure could be considered special for the purpose of this invention.

Regarding claims 2 & 3

Sankyo teaches conditions that correspond to loss (failure) and win (hit) (see abstract).

Regarding claims 4, 6, 12 & 14

Sankyo teaches that his gaming matching has three reels with a plurality of various types and sizes of symbols arranged in a sequence (see figure 22).

Regarding claim 7

Sankyo teaches that at least one of the symbols is presented at least three times in succession (see figure 22).

Regarding claims 13

Sankyo does not explicitly teach the colors of his symbols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use whatever color desired since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of color does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

Regarding claim 15

Sankyo teaches that moveable symbols are stopped in order to display win of failure (see abstract).

2. Claims 11, 2-4, 6, 7, 12-15 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sankyo K.K. in view of Kimura.

Further to the aforementioned teachings of Sankyo K.K., Kimura discloses a Game Machine With Selective Stop Means For Moving display. Kimura explicitly teaches spinning reels, symbols associated with the state of the game and reels controlled by the player by stop means (19, 20 & 21) (also see abstract and claim 1).

It would be obvious to include the teaching of Sankyo K.K.'s reel design to the machine of Kimura. This modification would be considered a mere matter of design choice (since Sankyo K.K. implicitly teaches all the other features of a regular game machine) and would be recognized as being within the level of one of ordinary skill in the art.

### ***Response to Arguments***

Applicant's arguments filed 1/20/04 have been fully considered but they are not persuasive.

Applicant argues that the cited references to Sankyo K.K. and Kimura fail to teach the claimed invention prior to the amendments presented in his response. Examiner disagrees with this argument because applicant's invention, as claimed, has structure that is known in the art. Further, in applicant's amendments he simply added limitations that are also known in the gaming art to be performed by slot and gaming machines.

Referring to the preamble of claim 11, game states (e.g. win/loss, symbol combination(s) predetermined or otherwise), by applicant's own admission on pages 1-4 (Description of the related Art), are known to gaming machines. Display portions having winning lines, rotatable reels, plurality of symbols appearing in succession in a "first display element" and stopping mechanisms used by players to stop reels are all taught by the cited references (as shown above) and known in the gaming machine art.

Applicant added new claim 16 simply adds a second display element and an additional player-actuable stop arrangement which is clearly taught by Kimura in figure 2 (19, 20, 21) and col. 2, lines 55-58.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Dolores R. Collins*** whose telephone number is **(703) 308-8352**. The examiner can normally be reached on 8.00 A.M. - 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ***Derris Banks*** can be reached on **(703) 308-1745**. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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March 4, 2004



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